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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,615	12/05/2003	Ronald J. Mathis	111440.02	7898

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GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC  
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MANCHESTER, NH 03101

EXAMINER

MCAVOY, ELLEN M

ART UNIT PAPER NUMBER

1764

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/727,615

Applicant(s)

MATHIS ET AL.

Examiner

Ellen M. McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8,9,12-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,9,12-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 17 July 2006.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-17 are still provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/684,427. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods of producing the lubricious coating comprising a polymer particle and water may be the same and the coating may be applied to a target surface wherein water may be added immediately prior to or after applying the coating to a target surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants’ response that they are prepared to file a terminal disclaimer to overcome this rejection upon the indication of allowable subject matter has been noted.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-6, 8, 9, 12-20 and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harlukowicz et al (6,642,351) alone or in combination with Yagi et al (5,258,424).

Harlukowicz et al ["Harlukowicz"] disclose polymer compositions comprised of small, dry polyacrylamide particles dispersed into water at industrially useful rates to form aqueous compositions. The resulting aqueous compositions may be used as a treating solution in diverse applications such as flocculants in water treating, papermaking, mining, oil field, and biotechnological separations. Harlukowicz teaches that the dispersal of polymer particles in water is achieved by separating the dry polyacrylamide particles from each other to form an airborne stream of separated polyacrylamide particles, then contacting the airborne stream with a stream of flowing water to form the desired aqueous compositions. Harlukowicz teaches that the polyacrylamides may be prepared by using techniques generally well-known to those skilled in the art including polymerization in solution, water-in-oil emulsion, water-in-oil microemulsion or aqueous dispersion. See column 4, lines 42-55. Harlukowicz teaches that the polyacrylamide particles have a particle size of about 300 microns or less, preferably 150 microns or less. See

column 4, lines 56-66. Harlukowicz teaches that in some cases, the aqueous composition may contain more than 5% of dispersed polymer by weight. See column 6, lines 53-60. The examiner is of the position that the aqueous compositions of Harlukowicz meet the limitations of the compositions of the above rejected claims. Although a coating composition is not specifically set forth, the term “coating” is found in the preamble which is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Harlukowicz teaches that the aqueous polyacrylamide compositions may be added to suspended solids such as biological solids, mineral slurry, oily water and cellulosic slurry. See column 9, lines 3-8. Thus the examiner is of the position that Harlukowicz meets the limitations of independent claim 18 which comprises the polymer particles in oil. The open-ended claim language “comprising” allows for the addition of other additives to the composition, even in major amounts, such as water.

Applicants' invention may differ in some dependent claims by applying the aqueous composition to a target surface which is not set forth in Harlukowicz. However, Yagi et al [“Yagi”] is added to teach that aqueous compositions containing polyacrylamide particles may be applied to surfaces where it may act as a coating. Thus the examiner is of the position that it would have been obvious to the skilled artisan to have applied the aqueous compositions of Harlukowicz to a surface if so desired.

The rejection of claims 1-23 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific polymer products set forth, does not reasonably provide enablement for all polymer particles, made in the previous office action is withdrawn in view of applicants' amendments to the claims.

The rejection of claims 1-17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yagi et al (5,258,424) made in the previous office action is withdrawn in view of applicants' claim amendments and arguments.

The rejection of claims 18-23 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roberts, Sr. et al (5,834,553) made in the previous office action is withdrawn in view of applicants' claim amendments and arguments.

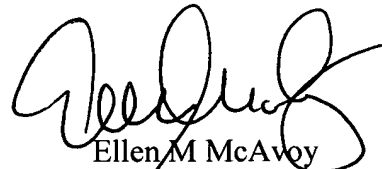
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
September 24, 2006